



P/2167-158

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Albert Kwang-Hwa SUN, et al.

Date: June 15, 2000

Serial No. : 09/495,393

Group Art Unit: Unknown

Filed : January 31, 2000

Examiner: Unassigned

For : SYSTEM AND METHOD FOR INTEGRATING TRADING
OPERATIONS INCLUDING THE GENERATION, PROCESSING AND
TRACKING OF AND TRADE DOCUMENTS

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

JUN 26 2000

DECLARATION OF MARK KESSELEN
IN SUPPORT OF PETITION UNDER 37 C.F.R. 1.47

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Sir:

I, Mark Kesslen, declare as follows:

1. I am an employee of The Chase Manhattan Bank ("Chase"), the assignee of the present application, and function as Chase's Chief Patent Counsel.

2. I am attorney registered to practice before the United States Patent and Trademark Office (Reg. No. 34848).

3. I have been administratively responsible for obtaining the inventor's signatures on the Declaration and Assignment documents in connection with this application.

4. At the time of the invention which is the subject matter of the application, inventor Sol Solomon was an employee of Chase. The invention resulted from work performed for Chase by several inventors, including inventor Sol Solomon, as employees of Chase. As an employee of Chase, Mr. Solomon was, and still is, under an obligation to assign all of his rights in the invention to Chase. Mr. Solomon subsequently left Chase and, to the best of my knowledge, is an independent contractor.

5. On December 17, 1999, my attorneys, Ostrolenk, Faber, Gerb, & Soffen, LLP ("OFGS") forwarded a final draft of a Taiwanese patent application covering the invention which is the subject matter of the present application as well as the formal documents in connection with the Taiwanese application to Bee Yoke Yap, one of the co-inventors on the present application. Ms. Yap coordinated with the other inventors in the review of the Taiwanese application and in the execution of the formal documents.

6. Ms. Yap forwarded a copy of the application and the formal documents to Mr. Sol Solomon for his review and execution.

7. On or about December 20, 1999, Ms. Yap advised me that she had been unable to obtain Mr. Sol Solomon's cooperation in the execution of the formal documents. Accordingly, Ms. Yap and I had at least two telephone conferences with Mr. Solomon on or about December 20-22, 1999 in an attempt to obtain Mr. Solomon's signature on the documents. Mr. Solomon refused to sign the Declaration and Power of Attorney at that time.

8. On December 23, 1999, pursuant to my instructions, OFGS filed the application for patent in Taiwan. Additionally, OFGS filed corresponding applications for patent in the Phillipines on December 22, 1999, in Thailand on December 22, 1999, and in the U.S. Receiving Office of the Patent Cooperation Treaty (PCT) (Serial No. PCT\US99\30976) on December 23, 1999.

9. On February 7, 2000, OFGS forwarded to me a copy of the present United States patent application as filed on January 31, 2000 (Serial No. 09/495,393), as well as copies of a Declaration and Power of Attorney in connection with the application. A copy of the letter is annexed hereto as Exhibit A. OFGS requested in that letter that I forward these documents to the inventors for their execution, which I immediately did.

10. U.S. Patent Application Serial No. 09/495,393 is based on and claims priority to PCT Patent Application Serial No. PCT\US99\30976.

11. I did not, however, immediately forward the U.S. documents to Mr. Solomon in light of my recent efforts to obtain his signature on the Affidavits and Declarations and Power of Attorney for the Taiwanese application. Instead, I contacted one of Chase's employees in Sydney, Australia, Mr. David Perkins of the Chase Legal Department, and instructed him to contact Mr. Solomon and attempt to obtain his signature on the documents. I advised Mr. Perkins that I would have OFGS forward the relevant documents to him.

12. I then specifically requested that OFGS forward a copy of the Affidavits, Declarations and Powers of Attorney for the present U.S. application and the corresponding PCT, Philippine, Taiwan and Thailand applications to Mr. Perkins in Australia and request that Mr. Perkins attempt to obtain Mr. Solomon's signature. OFGS forwarded these documents to Mr. Perkins by various letters. The Declaration and Power of Attorney for the present U.S. application were forwarded to Mr. Perkins by OFGS by letter dated February 7, 2000. A copy of the letter is annexed hereto as Exhibit B. I received a courtesy copy of this letter from OFGS.

13. On February 18, 2000, Michael J. Scheer, Esq. of OFGS and I had a telephone conference with Mr. Perkins to review what documents Mr. Perkins needed to have Mr. Solomon execute. During that conversation, OFGS agreed to resend copies of all the Affidavits, Declarations and Powers of Attorneys for the present U.S. application as well as the PCT and foreign applications to Mr. Perkins in one package to eliminate any confusion as to what needed to be executed by Mr. Solomon. OFGS sent those documents to Mr. Perkins by letter dated that same day - February 18, 2000. A copy of the letter is attached hereto as Exhibit C.

14. Mr. Perkins then took the following steps to contact Mr. Solomon and to obtain his signature on the documents. Mr. Perkins reported back to me and informed me of his actions in this regard and of his communications with Mr. Solomon.

15. Mr. Perkins forwarded to Mr. Solomon a copy of the patent application and the above documentation that needed to be executed by Mr. Solomon. Mr. Perkins then arranged to meet Mr. Solomon in Melbourne, Australia in the last week of March. Subsequent to



receiving the documents from Mr. Perkins and prior to the scheduled Melbourne meeting, Mr. Solomon telephoned Mr. Perkins indicating that he had reviewed the documents and that he would not sign them. Mr. Perkins encouraged Mr. Solomon to still meet with him in Melbourne to discuss the documents and Mr. Solomon agreed to such a meeting.

16. Mr. Perkins met with Mr. Solomon in Melbourne on March 28, 2000 and discussed the documents. Mr. Perkins, however, reported to me that he was unsuccessful in persuading Mr. Solomon to sign the documents. Mr. Perkins informed me that, at the conclusion of the meeting, Mr. Solomon continued in his refusal to execute the documents.

17. To date, inventor Sol Solomon has refused to execute the Declaration and Assignment forms with respect to this application.

18. I further declare that all statements made herein are of my own knowledge, are true, and that all statements made on information or belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this declaration, this application or any registration resulting therefrom.

Dated: June 16, 2000

By: 
Mark Kesslen